



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,554	12/09/2003	David H. Walker	D6152CIP2/D/D1	6350

7590 09/13/2005

David L. Parker  
FULBRIGHT & JAWORSKI L.L.P  
600 Congress Avenue, Suite 2400  
Austin, TX 78701

EXAMINER

BASKAR, PADMAVATHI

ART UNIT PAPER NUMBER

1645

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/731,554

Applicant(s)

WALKER ET AL.

Examiner

Padmavathi v. Baskar

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-4 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 2-3 (in part) and 4 drawn to a method of inhibiting *E.canis* infection comprising identifying a subject prior to exposure or suspected of being exposed to or infected with *E.canis and* administering a composition comprising 28kD antigen, For example: Recombinant protein SEQ.ID.NO: 2,said recombinant protein encoded by a Gene SEQ.ID.NO: 1 classified in class 514, subclass 44.
  - II. Claims 1, 2-3 (in part) and 4 drawn to a method of inhibiting *E.canis* infection comprising identifying a subject prior to exposure or suspected of being exposed to or infected with *E.canis and* administering a composition comprising 28kD antigen, For example: Recombinant protein SEQ.ID.NO: 4,said recombinant protein encoded by a Gene SEQ.ID.NO: 3 classified in class 514, subclass 44.
  - III. Claims 1, 2-3 (in part) and 4 drawn to a method of inhibiting *E.canis* infection comprising identifying a subject prior to exposure or suspected of being exposed to or infected with *E.canis and* administering a composition comprising 28kD antigen, For example: Recombinant protein SEQ.ID.NO: 6, said recombinant protein encoded by a Gene SEQ.ID.NO: 5 classified in class 514, subclass 44.
  - IV. Claims 1, 2-3 (in part) and 4 drawn to a method of inhibiting *E.canis* infection comprising identifying a subject prior to exposure or suspected of being exposed to or infected with *E.canis and* administering a composition comprising 28kD antigen, For example: Recombinant protein SEQ.ID.NO: 40, said recombinant protein encoded by a Gene SEQ.ID.NO: 39 classified in class 514, subclass 44.

Art Unit: 1645

- V. Claims 1, 2-3 (in part) and 4 drawn to a method of inhibiting *E.canis* infection comprising identifying a subject prior to exposure or suspected of being exposed to or infected with *E.canis* and administering a composition comprising 28kD antigen, For example: Recombinant protein SEQ.ID.NO: 42,said recombinant protein encoded by a Gene SEQ.ID.NO: 41 classified in class 514, subclass 44.
- VI. Claims 1, 2-3 (in part) and 4 drawn to a method of inhibiting *E.canis* infection comprising identifying a subject prior to exposure or suspected of being exposed to or infected with *E.canis* and administering a composition comprising 28kD antigen , For example: Recombinant protein SEQ.ID.NO: 44,said recombinant protein encoded by a Gene SEQ.ID.NO: 43 classified in class 514, subclass 44.
- VII. Claims 1, 2-3 (in part) and 4 drawn to a method of inhibiting *E.canis* infection comprising identifying a subject prior to exposure or suspected of being exposed to or infected with *E.canis* and administering a composition comprising 28kD antigen, For example: Recombinant protein SEQ.ID.NO: 46,said recombinant protein encoded by a Gene SEQ.ID.NO: 45 classified in class 514, subclass 44.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-VII are drawn to methods of inhibiting infection comprising identifying a subject prior to exposure or suspected of being exposed to or infected with *E.canis* and administering a composition comprising 28kD antigen , said antigen is a structurally different recombinant protein as evidenced by its structure , i.e., the sequence identification number SEQ.ID.NO: 2, 4 6,40, 42, 44 or 46 and is encoded by structurally different gene as represented by SEQ.ID.NO: 1, 3, 5, 39, 41, 43 or 45 respectively . These methods are distinct because each method utilizes a distinct recombinant protein that has its own structure and would not necessarily have the same effect on inhibiting the *E.canis* infection in a subject, i.e., horse or

Art Unit: 1645

dog. Thus each recombinant protein SEQ.ID.NO: 2, 4 6,40, 42, 44 or 46 having its own structure would not necessarily be art on the other in inhibiting *E.canis* infection.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their separate classification and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Conclusion**

7. Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform to the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The Right Fax number is 571-273-8300.

Art Unit: 1645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PMR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Padma Baskar Ph.D., whose telephone number is ((571) 272-0853. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 6.30 a.m. to 4.00 p.m. except First Friday of each bi-week.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.



Padma Baskar Ph.D.



LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600